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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,393

12/17/2004

Junko Deguchi

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22852

7590

09/19/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

WATKINS III, WILLIAM P

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,393	<b>Applicant(s)</b> DEGUCHI, JUNKO	
	<b>Examiner</b> William P. Watkins III	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>PTO Translation 08-1491</u> .          |

### **DETAILED ACTION**

1. The rejections given in sections 4 and 5 of the detailed portion of the office action mailed 12 December 2007 are withdrawn in view of applicant's amendments and arguments filed 11 June 2008. New art rejections against some of the claims are given below. A copy of PTO translation 08-1491 of JP-A 10298854 is attached to the instant office action and an appendix. This reference was cited in one of the withdrawn rejections.

2. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There is no suggestion in the art rejection given below of a waviness with the claimed cycle of 2,000 to 20,000 micrometers and claimed cycle width.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-9 and 11-12 are rejected under 35 U.S.C. 103(a) as obvious over Matsuzaki et al. (U.S. 6,647,550 B1).

Matsuzaki et al. teaches grooves in the outer surface of a swim suit fabric with a depth of 20 to 500 micrometers, a width of 200 to 1500 micrometers and a pitch of 300 to 3000 micrometers (col. 7, lines 35-40, Figure 3). The embossed fabric maybe made of elastic threads and maybe a two way tricot fabric (col. 4, lines 1-10, col. 7, lines 25-35). The instant invention claims streaky protruded portions with a width of 100 to 2500 micrometers, a height of 30 to 300% of the width and a compression ratio of 8 to 90%. It would have been obvious to one of ordinary skill in the art that the grooves of Matsuzaki et al. are defined by protruded portions that overlap in width and height the instant claimed height and width limitations. The compression ratio is taken as also being met by the reference as an elastic two way tricot is taught as a fabric with the compression ratio of the instant claims in Example 6 of the instant specification. The examiner takes a streaky protruding portion as being one which extends in the longitudinal direction.

5. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. in view of Jacobs (U.S. 5,836,016).

Matsuzaki et al. teaches protruded portions that reduce friction as noted above. Jacobs et al. teaches longitudinal strips that are wavy with a long cycle of multiple tens of inches (Figure 1, elements 40 and 22) in order to reduce friction in water (abstract). The instant invention claims portions that are wavy. It would have been obvious to one

of ordinary skill in the art to have made the grooves and projecting portions of Matsuzaki et al. wavy in order to further reduce friction because of the teachings of Jacobs et al.

6. Applicant's arguments with respect to claims 1, 3, 5-9 and 11-12 have been considered but are moot in view of the new ground(s) of rejection.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other swimsuit projection configurations.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/William P. Watkins III/

Primary Examiner, Art Unit 1794